

MIERSCH, Stefan

USSN: 10/008,603

**REMARKS/ARGUMENTS**

Claims 7-8 and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Garvin et al. (US 5,461,843) in view of Bremmer (US 4,579,654) and Chow (US 4,157,958). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Garvin et al. in view of Bremmer and Chow and further in view of Courtland (US 3,981,803). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Garvin et al. in view of Bremmer and Chow in view of Courtland and further in view of Pogoda (US 4,267,147). The Applicant believes that all of these rejections are improper because the proposed modifications of the primary reference, Garvin et al., are legally barred. In particular, the Applicant believes that the proposed modifications change the principle of operation of Garvin et al. and also, the modified invention of Garvin et al. would be unsuitable for the purpose of the invention of Garvin et al.

As stated in the Abstract, Garvin et al. disclosed:

"A method and apparatus for treating bagged materials" A... conduit... through the open end of the bag and into the bag... is perforated and when the bag is filled, the length of the conduit is extended out through the bag end to be connected to a treatment media, e.g., forced air. An opening is provided at the rear end to provide an exhaust opening for air that is forced into the conduit, out the perforations and through the bagged material. The air will dry the material to lower the moisture content or provide oxygen as may be desired to enhance decomposition."

Therefore, based on the abstract and FIG. 1, in at least one embodiment, the principle of operation for the invention of Garvin et al. is forcing air through a perforated conduit that extends through a bag of bagged materials such that the forced air from the perforated conduit flows through the bagged materials prior to escaping through an open vent. As stated in the specification the forced air is "vented to the atmosphere as indicated by arrows 36." See col. 4, lines 20-26. The purpose of this embodiment of Garvin et al. is to either dry the

Post Available Copy

*MIERSCH, Stefan**USSN: 10/008,603*

bagged material or provide oxygen to facilitate decomposition of the bagged material. See the abstract.

First, the proposed combination of references will impermissibly alter the principle of operation of Garvin et al. Instead of forcing air through the perforated conduit and then through the bagged material and then exhausting through a vent to the atmosphere, the modifications would require that the vent 34 be eliminated so that the methane gas emitted by the biomass would be able to remain within the bag to be collected through the perforated conduit. Also, instead forcing air through the conduit and into the biomass material, the modified combination would require that methane gas from the bag flow through the conduit to a collection site. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Second, the proposed combination of references would render the modified disclosure of Garvin et al. unsuitable for the purpose of Garvin et al. Specifically, air would no longer be forced through the biomass and into the atmosphere to remove gases emitted from the biomass (water vapor and/or decomposition products). Note also, the presence of oxygen hinders the production and collection of methane due at least in part to the rapid and spontaneous reaction of methane with oxygen. Therefore, excluding oxygen by not forcing air through the biomass would not be satisfactory for the purpose of providing oxygen to enhance desired decomposition. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

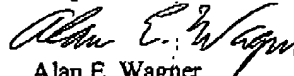
*MIERSCH, Stefan*

USSN: 10/008,603

For the above reasons, the Applicant believes that the Examiner's *prima facie* cases of rejection, all of which are based on Garvin et al., fail and that the Examiner should reconsider and withdraw his rejections. Therefore, the Applicant respectfully requests that the Examiner issue a Notice of Allowance for pending claims 7-12. The Applicant also requests that the Examiner rejoin and allow process claims 1-6 which related to a method of using the apparatus pending claims 7-12.

No fee or petition is believed to be due for the filing of this Response. However, any fee that is due should be charged to Deposit Account 23-2053. Any required petition should be considered provisionally made hereby.

Respectfully submitted,

  
Alan E. Wagner  
Registration No. 45,188

Dated: March 11, 2005

**P.O. ADDRESS:**

WHYTE HIRSCHBOECK DUDEK S.C.  
555 East Wells Street, Suite 1900  
Milwaukee, Wisconsin 53202  
(414) 273-2100  
Customer No. 022202

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**